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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/824,561	04/15/2004	Dave G. Pierre	118562-00102	6539

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BLANK ROME LLP
600 NEW HAMPSHIRE AVENUE, N.W.
WASHINGTON, DC 20037

EXAMINER

LAYNO, BENJAMIN

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 04/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/824,561

Applicant(s)

PIERRE, DAVE G.

Examiner

Benjamin H. Layno

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>02/18/05</u> | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. The claimed invention is directed to non-statutory subject matter.

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The claimed invention, recited in claims 1-9, is directed to the mere arrangement of printed matter on playing cards. A mere arrangement of printed matter, though seemingly a "manufacture" is rejected as not being within the statutory classes. See *In re Miller*, 418 f.2d 1392, 164 USPQ 46 (CCPA 1969); *Ex parte Gwinn*, 112 USPQ 439 (Bd. App. 1955); and *In re Jones*, 373 F.2d 1007, 153 USPQ 77 (CCPA 1967). In the present application, the claimed printed matter sets forth a mere arrangement of printed matter that is not functionally related to the substrate and, therefore, does not distinguish the invention from prior art in terms of patentability. Although printed matter must be considered, in this situation, it is not entitled patentable weight. The printed matter claimed herein conveys no meaningful information in regard to substrate they are arranged on and do not require any size relationship of the substrate, and do not require any particular substrate to effectively convey the information. Accordingly, there being no functional relationship of the printed material to the substrate, as noted above, there is no reason to give patentable weight to the content of the printed matter which, by itself is non-statutory subject matter. See *In re Sterling*, 70 F.(2d) 910, 21 C.C.P.A. 1134, *In re Russell*, 48 F.(2d) 668, 18 C.C.P.A. 1184, and *In re Reeves*, 62 F.(2d) 199, 20 C.C.P.A. 767.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-9 and 11-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kent in view of Matthews.

The patent to Kent discloses a set of playing cards divided into five suits, Figs. 7-11 (which is at least three suits). Each suit is divided into a predetermined number of cards including consecutively numbered cards "One" to "Nine", and non-numbered cards "Seal", "Tomb", "King", "Queen". The cards include historical indicia of the culture of ancient Egypt. The first suit is "Guard", the second suit is "Mummies", the third suit is "Dancers". The cards also include "Camels" and "Slaves".

The patent to Matthews teaches that it is known in the playing card art to form playing cards in a triangular shape. In view of such teaching, it would have been obvious to a person having ordinary skill in the art to form Kent's playing cards in a triangular shape in order for Kent's cards to more easily assemble in proper alignment for easy shuffling, and for Kent's cards to be more easily and readily spread into a fan shape in a player's hand.

The only difference between the claimed "pyramid", "ankh", "sphinx", "priest", "queen", "phararoh", "Ra" indicia on the cards of the claimed invention, and the

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"Guard", "Mummies", "Dancers", "Seal", "Tomb", "King", "Queen", "Camel", "Slaves"

indicia on the Kent's cards, resides in the meaning and information conveyed by printed matter. Such differences are considered unpatentable, *Ex parte Breslow*, 192 USPQ 431.

4. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kent in view of Matthews as applied to claim 1 above, and further in view of France.

The patent to France teaches that it is known to provide a triangular shaped box. Boxes for supporting playing cards are well known in the art. In view of France's teaching, it would have been obvious to provide a triangular shaped box for supporting Kent's modified triangular shaped playing cards. This modification would have provided a convenient way of storing and transporting Kent's modified triangular shaped playing cards.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 16-19 are rejected under 35 U.S.C. 102(b) as being anticipated by France et al.

Figure 6 of France et al. discloses a one-piece blank comprising a first triangular main panel 11, a second main panel 51, a first rectangular side panel 12 hinged at 14 to

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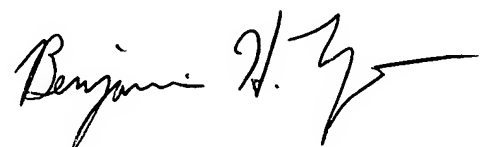
the first triangular main panel, a second rectangular side panel 13 hinged at 15 to the first triangular main panel, and a third rectangular side panel 43 hinged at 62 to the second triangular main panel. France's one-piece blank further includes a first flap 17 hinged at 18 to the first side panel and a second flap 64 hinged to the second main panel.

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The patent to Weislo discloses triangular shaped playing cards.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin H. Layno whose telephone number is (571) 272-4424. The examiner can normally be reached on Monday-Friday, 1st Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on (571) 272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

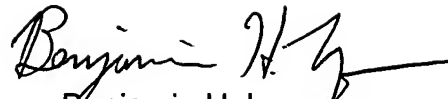
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Benjamin H. Layno", followed by a stylized flourish.

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Benjamin H. Layno
Primary Examiner
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bhl